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10/707148

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11-24-2003

First Named Inventor

CHABOT

Art Unit

3761

Examiner Name

GARCIA

Attorney Docket Number

6536-0301

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☒

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

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Information Disclosure Statement

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Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

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Petition

☐Petition to Convert to a
Provisional Application☐Power of Attorney, Revocation
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After Allowance Communication to TC

☐Appeal Communication to Board
of Appeals and Interferences☒Appeal Communication to TC
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Proprietary Information

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Chabot & Associates

Signature

Printed name

Ralph D. Chabot

Date

07-18-2005

Reg. No.

39,133

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Attorney Docket No: 6536-0301

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Chabot

Serial No: 10/707148

Filed: November 24, 2003

Art Unit: 3679

Examiner: Ernesto Garcia

For: Method for Limiting the Movement of an Infant in a Particular Direction

APPEAL BRIEF

(1) Real party in interest

Inventor.

(2) Related appeals and interferences

None.

(3) Status of Claims

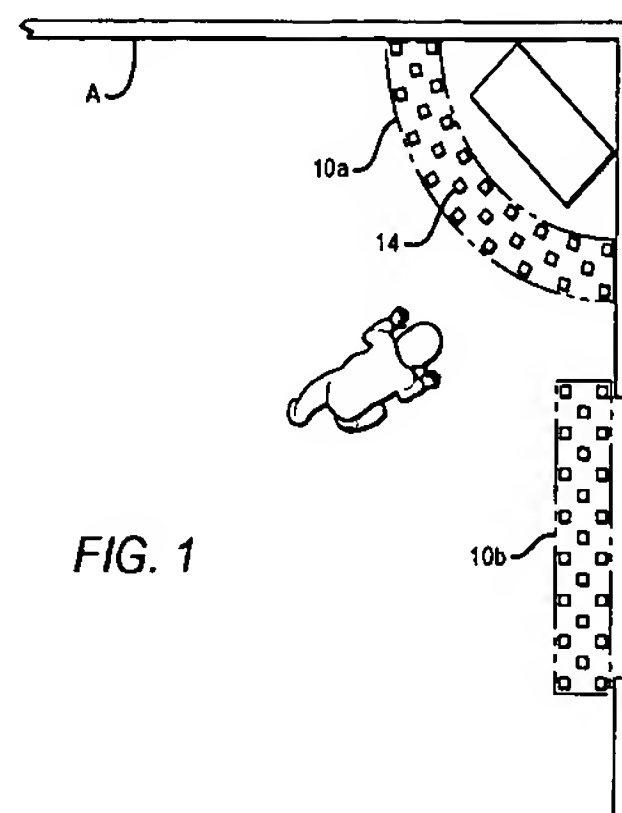
Pending claims 2-10 have been rejected and have not been amended since the Office Action Made Final mailed 05/06/2005. Claim 1 has been canceled pursuant to a restriction requirement.

(4) Status of Amendments

The appellant filed an amendment submitting a replacement drawing sheet in response to Form PTO-948. The replacement drawing sheet was determined to be acceptable according to the "Advisory Action Before the Filing of an Appeal Brief" (PTOL-303) mailed 05/26/2005.

(5) Summary of Invention

Appellant's invention is a method for limiting the movement of infants in a particular direction by the sizing and placement of an appropriately designed barrier upon flooring. The following is Fig. 1 from applicant's submission:



The examiner has rejected pending claims 6, 9 and 10 on the basis of 35 USC §112 second paragraph and rejected pending claims 2-10 on the basis of 35 USC §102. The rejected claims are set forth in Appendix A.

The following are passages from the specification that describe the invention. Since the application was electronically filed, bracketed paragraphs reference the appropriate paragraph of the specification.

- Important aspects are that the barrier be of a sufficient length and width to prevent an infant from either: a) reaching an undesired place such as a drawer or cabinet; or, b) being able to cross over the barrier. The barrier must comprise a plurality of upward extending sections that have a top surface design that is incapable of puncturing the skin of an infant or that is generally not harmful to the infant but that will discourage traversing. The barrier must also be low-profile to prevent the infant from being able to grab or remove certain portion of the barrier in its entirety. **[Paragraph 0005]**.
- The barrier is designed to have a low profile so that adults and older children will have no difficulty stepping across or reaching over. **[Paragraph 0007]**.

- For hard floor surfaces such as wood, tile, or vinyl, the barrier can be adhesively attached either directly to the flooring or by the use of Velcro®. **[Paragraph 0008]**.
- The upward extending section design has a low-profile so that it is difficult for an infant to grab and detach or to cause injury if fallen upon. Therefore, the substantially upward extending section is of a very short length. The low profile and barrier configuration permits adults to walk over the barrier with no difficulty. **[Paragraph 0011]**.
- In the situation where the infant is crawling, the barrier design should be capable of causing discomfort to the hand or knee if the infant attempts to cross the barrier and put its weight on its hand or knee. In the situation where the infant is walking, the barrier design should be capable of causing discomfort to the feet. **[Paragraph 0012]**.
- Creating a barrier across the entrance to a room allows the infant to move about the room rather than being limited to the confined space of a play-pen. No unsightly fences or gates are required. Older children and adults would have no difficulty walking across the barrier. **[Paragraph 0017]**.
- It should be obvious that the barrier will not be effective when the infant is walking with shoes. Also, my method is for small infants preferably from the age they begin to crawl to approximately 16 months old, or when the infant has developed the cognitive skill to jump over the barrier or be able to slide a flat surface over the barrier to act as a bridge for crossing. **[Paragraph 0018]**.
- Each barrier is comprised of a plurality of horizontal units 14. Each barrier can be a sheeting material upon which horizontal units are attached. **[Paragraph 0026]**.
- Once a barrier having a sufficient length and depth is positioned properly in front of a piece of furniture or entryway, the infant, not knowing the purpose of the barrier, will attempt to cross and thus place its weight on one or more of studs 12. The infant will experience temporary discomfort and may cry. However, the infant's learning mechanism will teach it not to cross the barrier. Once the infant is conditioned, it will not attempt to cross the barrier until it develops the

necessary cognitive skills to jump the barrier or place something over the barrier to protect it from studs 12. **[Paragraph 0030]**.

(6) Issues

Issue #1. Claims 6, 9 and 10 were rejected under 35 USC §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Issue #2. Claims 2-10 were rejected under 35 USC §102 as anticipated by U.S. Pat. No. 4,431,166 issued February 14, 1984 to Marshall for an invention entitled “Garbage Can Mat”.

(7) Grouping of claims

With respect to the rejection based upon 35 USC §112 second paragraph, claims 6, 9 and 10 stand or fall together.

With respect to the rejection based upon 35 USC §102, claims 2-10 stand or fall together.

(8) Argument

Issue #1. The 35 USC §112 second paragraph Rejection of Claims 6, 9 and 10.

A. The Examiner’s Rationale

In claim 6, the examiner bases his rejection on the claim phrase “which permits older children and adults to step over” as being uncertain which children are considered older and which adults are capable of stepping over.¹

The examiner noted:

“applicant has failed to provide any evidence to show that there is an existing ‘standard’ in the field of barrier mat manufacturing for sizing of mats to a person’s stepping gate. Therefore, any mat can be considered by applicant as having been ‘sized for older children and adults to step over’ while the manufacturer of the mat would believe otherwise. The same applies with regard to what constitutes an ‘older’ child. This being the case, whether the mat was covered by the claims or not would be determined not on the basis of structural

¹ Page 2, May 6, 2005 Office Action.

elements and their interrelationships, but rather by means of a label placed on the mat at the discretion of the manufacturer. This gives rise to uncertainty in the interpretation of the claims. As a result of this uncertainty, the question of correspondence between a particular mat and this requirement of the claims cannot be determined until a particular user attempts to step over the mat. Therefore, the same mat might fall within the language when one particular older child or adult uses it but not when another older child or adult uses it. This is improper. See *Ex parte Brummer*, 12 USPQ2d 1654 (1989).² (Emphasis added).

B. Appellant's Argument

The examiner has attempted to fit the pending application within the four corners of the *Ex parte Brummer* holding since the passage above is taken directly from that case and replacing the subject matter with the term “mat”.

The examiner's attempt to analogize *Ex parte Brummer* to the pending application is respectfully incorrect. A closer review of that case is necessary to illuminate the differences.

Ex parte Brummer focused on a claim 9 which included the claim element: “a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for...”. (Emphasis added). The panel in *Ex parte Brummer* then discussed why rejection was proper and based its decision on the uncertainty existing where a bicycle is considered by the appellant to fall within the scope of claim 9 while a manufacturer would not.

The facts here are markedly different. First and foremost, the claim is directed to a method for limiting the movement of an infant in a particular direction. The depth of the barrier is defined as that depth required to prevent an infant from attempting to cross while still allowing older children and adults to step across. Rather than considering that the barrier limits movement of an infant, the examiner focused only on the stepping gate of adults and older children (analogized to the wheelbase in *Ex parte Brummer*).

In *Ex parte Brummer*, the panel rejected the pending claims because the claimed bicycle wheelbase could be used by different persons; with infringement occurring for some riders but not for others. Because the claims presented uncertainty as to when infringement would occur,

² Page 2, Advisory Action Before the Filing of an Appeal Brief (PTOL-303) mailed 05/26/2005.

the panel upheld the examiner's rejection. In the present matter, the barrier is designed to prevent infants from crossing which is definite and clear to one skilled in the art.

Even if this panel is tempted to agree with the examiner that *Ex parte Brummer* is applicable, a more recent Federal Circuit decision clarifies the situation and provides a solid basis for concluding the examiner misapplied *Ex parte Brummer*. In *Exxon Research and Engineering Co. v. United States*, 265 F.3d 1371; 60 USPQ 2d 1272 (Fed. Cir. 2001) the court held:

If the meaning of a claim is discernible and the conclusion may be one over which reasonable persons will disagree, the CAFC has held the claim sufficiently clear to avoid invalidity on indefiniteness grounds. The fact that claims "include species that might not meet the objects of the invention does not by itself prove that one skilled in the art cannot ascertain the scope of the asserted claims".

If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP §2173.04; *In re Ehrreich and Avery*, 590 F.2d 902; 200 USPQ 504, 508 (C.C.P.A. 1979).

Applicant's position is that the examiner failed to consider more relevant case law and MPEP §2173.04, electing instead to improperly reject claim 6 on a non-relevant basis.

With respect to the examiner's issue that claim 6 is indefinite because of uncertainty over which children are considered older, this is clearly identified in the specification at paragraph 0018 as those children having developed the cognitive skill to jump over the barrier or be able to slide a flat surface over the barrier to act as a bridge for crossing. [Paragraph.0018].

The examiner has also based his indefiniteness rejection on the health or disabilities associated with children and adults:

"Further, since children and adults have many physical characteristics, it would be uncertain whether all children, able or disabled, will infringe on the subject matter. The claim does not appear to cover all instances for all children and adults, especially the elderly, and therefore the claim would be uncertain."³

³ Page 2, Office Action mailed 05/06/2005.

The ability of the examiner to enumerate variations (i.e. healthy, disabled children, etc.) encompassed by the claim language points up the weakness of his indefiniteness argument. Breadth is not indefiniteness. *In re Robins*, 166 USPQ 552 (CCPA 1970); MPEP §2173.04.

During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. MPEP §2173.05(a) citing *In re Morris*, 127 F.3d 1048, 1054; 44 USPQ 2d 1023, 1027 (Fed.Cir. 1997). “The PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” MPEP §2111.

If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more. MPEP §2173.05(a) citing *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F2d. 613; 225 USPQ 634 (Fed. Cir. 1985).

This is precisely the situation pending before this panel. One skilled in the art is apprised of the scope of the invention upon reading both the specification and claim 6.

In view of the holdings of *Exxon Research*, *In re Robins*, and *In re Ehrreich and Avery*, *infra*, and the argument presented, it is respectfully requested that the rejection of claims 6, 9 and 10 under 35 USC 112, second paragraph should not be sustained.

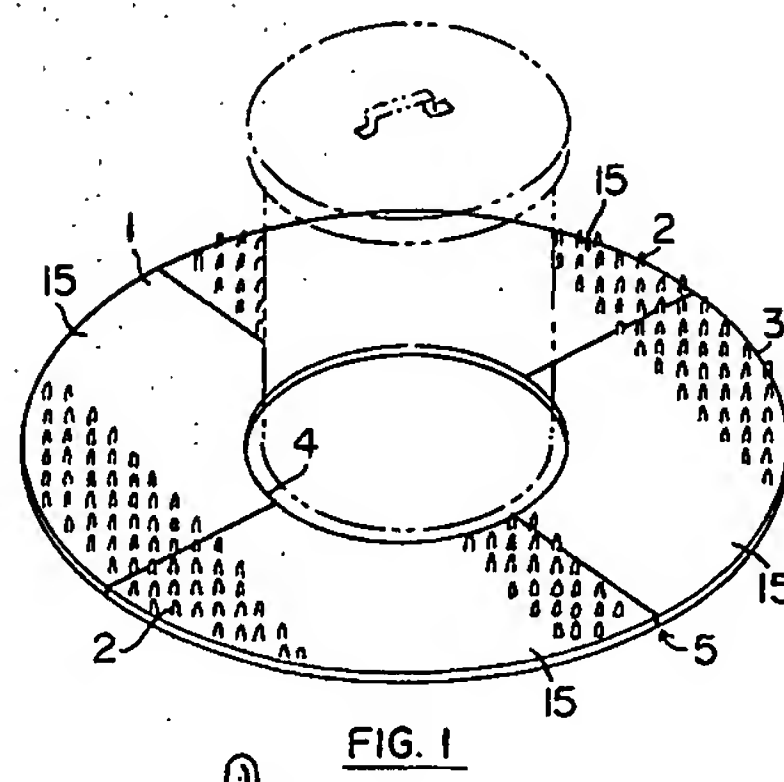
Issue#2. The 35 USC §102 Rejection of Claims 2-10 on the Marshall prior art.

A. The Examiner’s Rationale

In rejecting claims 2-5, the examiner held that Marshall discloses in Fig. 1 and Fig. 9, a method comprising the steps of:

- providing low-profile upward extending sections 2;
- appropriately sizing the length and the depth of a sheeting material 6 to substantially conform to a floor (see sizes of Figures 1 and 9); and,
- positioning the sheeting material across a portion of the floor.

The following illustration is Fig. 1 of the Marshall garbage can mat prior art reference:



The examiner summarizes the basis for his 102 rejection of claims 2-10:

“...it is well-established that the patentability of method claims is based on the recited method steps and not recited structure unless such structure is affected in the manipulative sense by the method steps. Applicant states he is unaware of any provision in the MPEP or case law to support this position. It is not clear what point applicant is seeking to make with this statement since an applicant’s awareness of proper procedure and policy is not the standard for determining patentability. Nevertheless, applicant’s attention is directed to *Ex parte Pfeiffer*, 135 USPQ 31, 1962 C.D. 408 (1961).”⁴

B. Appellant’s Argument

Stated simply, the Marshall reference does not teach, nor suggest, appellant’s method for using a barrier to limit movement of an infant. It is improper to base an anticipation rejection on 35 USC §102 using a reference that does not teach nor suggest appellant’s novel method of limiting the movement of an infant in a particular direction.

When I queried the examiner with respect to my unawareness of any provision in the MPEP or case law to support his position, I did so to elicit the legal grounds supporting his position for preparing my argument to this panel. Prior to providing the *Ex parte Pfeiffer* reference, the examiner had consistently relied upon his interpretation of 35 USC 102 without support.

⁴ Pages 2-3, Advisory Action Before the Filing of an Appeal Brief (PTOL-303) mailed 05/26/2005.

I continue to be unaware of any provisions in the MPEP or case law that support the examiner's position. *Ex parte Pfeiffer* is not relevant; its holding having been taken out of context. More importantly, the examiner has not relied upon a single applicable section of the MPEP to support his position. For the reasons that follow, the holding of *Ex Parte Pfeiffer* has been misapplied by the examiner to improperly reject claims 2-10.

1. Misapplication of *Ex parte Pfeiffer*

The panel in *Ex parte Pfeiffer* determined that the relied-upon references taught the same method concept as the pending claims on appeal; specifically, the transfer of fluid material from an aeroplane to the ground by freely dropping a bag containing such material from the aeroplane without the necessity of a parachute. This is markedly different than the application pending on appeal where the same method is not taught nor suggested by the Marshall reference.

In *Ex parte Pfeiffer*, applicant's differences in the height from which the bags were released was ruled not to alter the method; nor was applicant's claimed use of rubber as the composite bag material. To summarize, the reason the board rejected the appeal in *Ex Parte Pfeiffer* was because the applicant was attempting to claim the same identical method; varying only the bag release height and its composition.

By contrast, the methods of use are clearly distinguishable between the pending claims and the Marshall reference. The examiner's prior-art reference is directed to a trash can mat that is located about the perimeter of a garbage can. The mat has to be sufficiently wide to carry out its intended purpose; that being to prevent a large dog from standing on its hind legs and then use its weight to knock over the garbage can. As described in the specification, the mat comprises a plurality of spikes that are of sufficient length to penetrate past the paw pads of a large dog and inflict pain to the adjacent soft tissue. The mat is designed to be stood upon so an adult may deposit trash into the container.

The Marshall reference implicitly defines the range for the depth of the mat to be that which would deter a large dog from knocking over a trash can and that range must also be sufficiently wide so that an adult must step upon the mat in order to get close enough to remove the trash can cover and deposit trash into the can. The Marshall reference also requires that the

invention have mat ring modules which are snap-fastened together to form an enclosing barrier for a garbage can⁵; something the pending application does not.

To find anticipation of claims, the prior-art embodiments must possess the properties expressly recited in the claims. Property limitations can serve to distinguish claimed subject matter from other products. *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

The depth of the barrier in the claimed invention can not be the same and must be less than the depth of Marshall's garbage can mat. The barrier depth is sized to deter an infant from attempting to cross while permitting adults and older children to cross. The Marshall reference does not teach nor suggest crossing the mat; rather, it requires standing upon the mat.

If Marshall's garbage can mat were sized according to applicant's method of using a barrier, i.e. to allow for adults and older children to cross, the intended purpose of Marshall would be defeated. In other words, if Marshall's mat were appropriately sized so older children and adults could step across, so too could a large dog position its hind legs behind the barrier and still be able to place its front paws upon the garbage can to knock over.

To summarize the differences, the Marshall reference describes a garbage can mat to prevent large dogs from knocking over the garbage can surrounded by the mat⁶ while the pending application presents claims directed to a method to limit the movement of an infant in a particular direction.

Applicant submits the purposes of the prior art reference and pending claims are clearly distinguishable to the extent there can be no valid rejection on the basis of anticipation. Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate. *Glaverbel Societe Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995).

⁵ U.S. Pat. No. 4,431,166 Col. 1, lines 39-41

⁶ U.S. Pat. No. 4,431,166 Col. 1, lines 47-49.

The examiner ignores the purpose of the prior art, electing instead to rely on selected claim elements to establish his ground for rejection. When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Mendenhall v. Astec Industries, Inc.*, 13 USPQ2d 1913, 1928 (Tenn. 1988), aff'd, 13 USPQ2d 1956 (Fed. Cir. 1989).

2. Preamble as a claim limitation

In determining whether anticipation exists, this panel should also consider the preamble of the pending claims contrasted to the Marshall reference. Applicant believes the preamble for each of the pending claims should be treated as a limitation of the claims.

While no litmus test defines when a preamble limits claim scope *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257; 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), whether to treat a preamble as a limitation is a determination “resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.* 289 F.3d 801, 808; 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention. *Catalina Mktg.*, 289 F.3d at 808; 62 USPQ2d at 1785; *Bristol-Myers Squibb Co., v. Ben Venue Labs.*, 246 F.3d 1368, 1375; 58 USPQ2d 1508, 1513 (Fed. Cir. 2001). So is the case for the pending application. The preamble is relied upon by the Applicant to distinguish the claimed invention from the prior art reference.

In Marshall, both independent claims use the following preamble: “A garbage can mat comprising...”.⁷ Representative of Applicant’s pending claims is claim 2 where the preamble reads: “A method for preventing movement of an infant from one area of a house to another by creating a barrier on a floor comprising the steps of”. The preamble for each pending claim is distinguishable from Marshall. Applicant, as here, has relied on her preambles to distinguish her claimed invention from the prior art. Because the preamble for each of the pending claims

⁷ Claims 1 and 2 of U.S. Pat. No. 4,431,166.

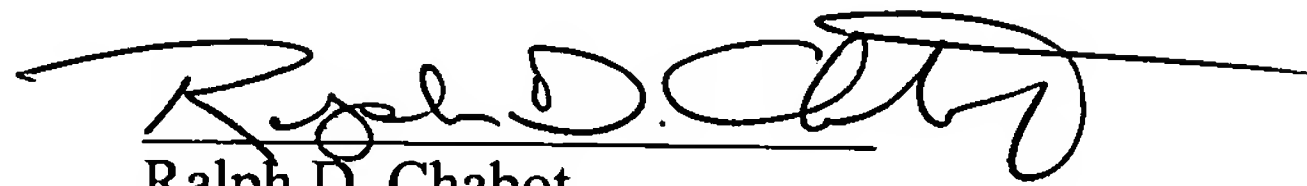
should be construed as a claim limitation, the examiner's rejection on the basis of anticipation is improper.

Summary

For the foregoing reasons, it is submitted the examiner's rejections of claims 2-10 were erroneous, and reversal of his decision is respectfully requested.

Respectfully submitted,

Dated: July 18, 2005

A handwritten signature in black ink, appearing to read "Ralph D. Chabot", written over a horizontal line.

Ralph D. Chabot
Reg. No. 39,133

(9)

APPENDIX A
REJECTED CLAIMS

Claim 2. A method for preventing movement of an infant from one area of a house to another by creating a barrier on a floor comprising the steps of:

providing a plurality of low-profile upward extending sections, each upward extending section having a top surface design that is incapable of puncturing the skin of an infant, said plurality of low-profile upward extending sections extend upward from the top surface of a sheeting material;

appropriately sizing the length and depth of the sheeting material to substantially conform to the portion of the floor intended to be placed upon; and,

positioning said sheeting material across said portion of the floor to create a barrier to prevent movement of the infant from one area of a house to another by providing the infant with temporary discomfort when the infant touches and applies its own weight to both the top surface of said sheeting material and to at least one of said top surface designs.

Claim 3. The method of claim 2 where said sheeting is adhesively attached to the flooring.

Claim 4. The method of claim 2 where said sheeting is attached to the flooring using hook and loop.

Claim 5. A method for preventing movement of an infant in a particular direction by creating a barrier on a floor comprising the steps of:

- providing a sheeting material, said sheeting material having a plurality of upward extending low profile sections, each low profile section having a top surface design that is incapable of puncturing the skin of an infant yet will provide temporary discomfort to the infant when the infant touches and applies its own weight to a portion of the sheeting material;

- appropriately sizing the sheeting material; and,

- positioning said appropriately sized sheeting material in a desired location upon a floor to create a barrier to prevent movement of an infant in a direction across the barrier.

Claim 6. A method for preventing an infant from moving from one area of a house to another by creating a barrier upon a portion of a floor comprising the steps of:

providing a sheeting material having a low profile top surface design, said low profile top surface design comprising a plurality of upward extending sections having respective distal ends, said low profile top surface design having a limited height which permits older children and adults to step over and said distal ends designed to provide temporary discomfort when the infant touches and applies its own weight to a portion of said sheeting material; said limited height further defined as being sufficiently short so that an infant would not be able to grab and detach any of said upward extending sections;

sizing said sheeting material for the portion of said floor upon which said sheeting material is to be placed, said sheeting material sized for older children and adults to step over while still providing sufficient depth to discourage an infant from attempting to cross; and,

placing said sheeting material upon a floor in a substantially desired location to create a barrier preventing movement of an infant from one area of a house to another.

Claim 7. The method of claim 5 where said sheeting is adhesively attached to the flooring.

Claim 8. The method of claim 5 where said sheeting is attached to the flooring using hook and loop.

Claim 9. The method of claim 6 where said sheeting is adhesively attached to the flooring.

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Claim 10. The method of claim 6 where said sheeting is attached to the flooring using hook and loop.

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